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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,389	10/27/2003	Kassab Al-Mahareeq	03/09-01	1646
61365 7590 03/31/2009 OVERHAUSER LAW OFFICES, LLC DOCKETING DEPARTMENT 737 W. GREEN MEADOWS DRIVE, SUITE 300 GREENFIELD, IN 46140				
EXAMINER				
NAGPAUL, JYOTI				
ART UNIT		PAPER NUMBER		
1797				
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03/31/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/693,389

Applicant(s)

AL-MAHAREEQ ET AL.

Examiner

JYOTI NAGPAUL

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 and 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Amendment filed on December 17, 2009 has been acknowledged. Claims 2 and 4-6 are pending.

Response to Amendment

Rejection of Claims 4 and 6 as being anticipated by Yonkers (US 4599220) has been withdrawn in light of applicants' amendments.

Rejection of Claims 2 and 5 as being unpatentable over Yonkers (US 4599220) has been withdrawn in light of applicants' amendments.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 2 and 4** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is "a pipette tip ejector having a striker portion for striking the upper edge of the pipette tip, the ejector axially movable between a proximal retracted position and a distal ejecting position, the striker portion positioned axially proximal of the first

and second annular pipette tip stops in the retracted position and positioned axially distal of the first and second annular pipette tip stops in the ejecting position."

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

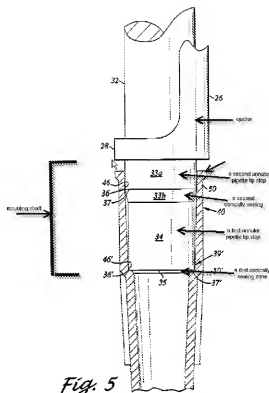
4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claims 2 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rainin et al. (US 6967004)

Rainin teaches a pipette tip and mounting shaft combination in an air displacement pipette. Rainin teaches a mounting shaft (22) configured to alternatively engage and retain one at a time of a pipette tip (40) of a first diameter and a pipette tip (40) of a second diameter. The mounting shaft (40) comprising a first conically tapered sealing zone selectively capable of being engaged with the pipette tip of a first diameter and a second conically tapered sealing zone selectively capable of being engaged with the pipette tip of a second diameter. (Refer to Figure below) Rainin further teaches a second annular pipette tip stop abutting the second sealing zone. The second stop being perpendicular to the axis defining the first and second conically tapered sealing zones and having an inner diameter equal to the wide end of the second sealing zone. (Refer to Figure below) Rainin further teaches a pipette ejector (26) having a striker portion for striking the upper edge of the pipette tip. The ejector axially movable between a proximal retracted position and a distal ejecting position. The striker portion positioned axially proximal of the first and second annular pipette tip stops in the retracted position and positioned axially distal of the first and second annular pipette tip stops in the ejecting position. (Refer to Figure below)



Rainin fails to teach first sealing zone comprising a narrow end with an *outer diameter of 0.18 to 0.20 inches*, a wide end with an *outer diameter of 0.20 to 0.22 inches* and being *0.10 to 0.15 inches long*, to thereby form a tapered at an angle of 84 to 90 degrees with respect to the plane perpendicular to the axis of the first sealing zone. Yonkers further fails to teach a second sealing zone comprising a narrow end with an *outer diameter of 0.22 to 0.24 inches*, a wide end with an outer diameter of 0.24 to 0.26 inches and being 0.13 to 0.17 in. long.

It would have been obvious to a person of ordinary skill in the art to modify the device of Rainin to provide a first sealing zone comprising a narrow end with an *outer diameter of 0.18 to 0.20 inches*, a wide end with an *outer diameter of 0.20 to 0.22 inches* and being *0.10 to 0.15 inches long* and a second sealing zone comprising a

narrow end with *an outer diameter of 0.22 to 0.24 inches*, a wide end with an outer diameter of *0.24 to 0.26 inches* and being *0.13 to 0.17 in. long* in order to create a fluid tight seal between the tip and shaft and obtain the desired lateral stability for tip on the shaft. See In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 4 and 6** are rejected under 35 U.S.C. 102(b) as being anticipated by Rainin.

Refer above for the teachings of Rainin.

Rainin further teaches, in Figure 5, it appears the upper and lower ends are at an angle of 84 to 90 degrees with respect to the plane perpendicular to axis of the first sealing zone and second sealing zone.

Response to Arguments

9. Applicant's arguments with respect to claims 2 and 4-6 have been considered but are moot in view of the new ground(s) of rejection. Refer to the rejection above.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI NAGPAUL whose telephone number is (571)272-1273. The examiner can normally be reached on Monday thru Friday (10:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JN

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797